

Mail Stop Patent Application,
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Atty Dkt No. SABI-002/03US (97-US4)

RECEIVED
MAY 19 2003
TECH CENTER 1600/2900

FORM PTO-1449 (Modified)
LIST OF PATENTS AND PUBLICATIONS
FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)
Sheet 1 of 4

In the Application of CASE et al.

Serial No.: 09/942,090

Art Unit: 1631

Filed: August 28, 2001

Examiner: Unassigned

Title: GENE IDENTIFICATION

U.S. PATENT DOCUMENTS

Exam. Init.	Ref. Desig.	Document No.	Date	Name	Class	Sub Class	Filing Date

FOREIGN PATENT DOCUMENTS

Exam. Init.	Ref. Desig.	Document No.	Publication Date	Country or Patent Office	Class	Sub Class	Translation YES NO	
	B1	WO 99/35494	July 15, 1999	PCT				
	B2	WO 00/41566	July 20, 2000	PCT				
	B3	WO 00/42219	July 20, 2000	PCT				

OTHER DOCUMENTS (including Author, Title, Date, Pertinent Pages, etc.)

Exam. Init.	Ref. Desig.	Description
	C1	Bailey et al., "Analysis of EST-Driven Gene Annotation in Human Genomic Sequence," <i>Genome Research</i> 8:362-376 (1998)
	C2	Beerli et al., "Toward Controlling Gene Expression at Will: Specific Regulation of the <i>erbB-2/HER-2</i> Promoter by Using Polydactyl Zinc Finger Proteins Constructed from Modular

Examiner:

Date Considered:

EXAMINER: Initial if citation considered whether or not the citation conforms with MPEP609. Draw a line through the citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

643552 v1/PA
DSKG011.DOC



Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Atty Dkt No. SABI-002/03US (S7-US4)

RECEIVED
MAY 19 2003
TECH CENTER 1600/2900

FORM PTO-1449 (Modified)
LIST OF PATENTS AND PUBLICATIONS
FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)
Sheet 2 of 4

In the Application of CASE et al.

Serial No.: 09/942,090

Art Unit: 1631

Filed: August 28, 2001

Examiner: Unassigned

Title: GENE IDENTIFICATION

Exam. Init.	Ref. Desig.	Description
		Building Blocks," <i>Proc. Natl. Acad. Sci. U.S.A.</i> <u>95</u> :14628-14633 (1998)
	C3	Birney et al., "PairWise and SearchWise: Finding the Optimal Alignment in a Simultaneous Comparison of a Protein Profile Against All DNA Translation Frames," <i>Nucleic Acids Research</i> <u>24</u> (14):2730-2739 (1996)
	C4	Brasemann et al., "A selective transcriptional induction system for mammalian cells based on Gal4-estrogen receptor fusion proteins," <i>Proc. Natl. Acad. Sci. USA</i> <u>90</u> :1657-1661 (1993)
	C5	Burge et al., "Prediction of Complete Gene Structures in Human Genomic DNA," <i>J Mol. Biol.</i> <u>268</u> :78-94 (1997)
	C6	Camargo et al., "The Contribution of 700,000 ORF Sequence Tags to the Definition of the Human Transcriptome," <i>PNAS</i> <u>98</u> (21):12103-12108 (2001)
	C7	Choo et al., "Toward a Code for the Interactions of Zinc Fingers with DNA: Selection of Randomized Fingers Displayed on Phage," <i>Proc. Natl. Acad. Sci. U.S.A.</i> <u>91</u> :11163-11167 (1994)
	C8	Choo et al., "In Vivo Repression by a Site-Specific DNA-Binding Protein Designed Against an Oncogenic Sequence," <i>Nature</i> <u>372</u> :642-645 (1994)
	C9	Claverie, Jean-Michel, "Computational Methods for the Identification of Genes In Vertebrate Genomic Sequences," <i>Human Molecular Genetics</i> <u>6</u> (10):1735-1744 (1997)
	C10	Dunham et al., "The DNA Sequence of Human Chromosome 22," <i>Nature</i> <u>402</u> :489-495 (1999)
	C11	Florea et al., "A Computer Program for Aligning a cDNA Sequence With a Genomic DNA Sequence," <i>Genome Research</i> <u>8</u> :967-974 (1998)
	C12	Galas, David J., "Making Sense of the Sequence," <i>Science</i> <u>291</u> :1257-1260 (2001)

Examiner:

Date Considered:

EXAMINER: Initial if citation considered whether or not the citation conforms with MPEP609. Draw a line through the citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

643552 v1/PA
DSKG011.DOC



Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Atty Dkt No. SABI-002/03US (S-100)

RECEIVED
MAY 19 2003
TECH CENTER 1600/2900

FORM PTO-1449 (Modified)
LIST OF PATENTS AND PUBLICATIONS
FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)
Sheet 3 of 4

In the Application of CASE et al.

Serial No.: 09/942,090

Art Unit: 1631

Filed: August 28, 2001

Examiner: Unassigned

Title: GENE IDENTIFICATION

Exam. Init.	Ref. Desig.	Description
	C13	Gelfand et al., "Gene Recognition Via Spliced Sequence Alignment," <i>Proc. Natl. Acad. Sci. U.S.A.</i> <u>93</u> :9061-9066 (1996)
	C14	Goodman, "The Case of the Missing Gene," <i>Genome Technology</i> pp. 52-55 (July, 2001)
	C15	Guigó et al., "An Assessment of Gene Prediction Accuracy in large DNA Sequences," <i>Genome Res.</i> <u>10</u> :1631-1642 (2000)
	C16	Hagmann et al., "The VP16 Paradox: Herpes Simplex Virus VP16 Contains a Long-Range Activation Domain but within the Natural Multiprotein Complex Activates Only from Promoter-Proximal Positions," <i>Journal of Virology</i> <u>71</u> :5952-5962 (1997)
	C17	Heix et al., "Mitotic silencing of human rRNA synthesis: inactivation of the promoter selectivity factor SL1 by cdc2/cyclin B-mediated phosphorylation," <i>EMBO Journal</i> <u>17</u> :7373-7381 (1998)
	C18	Hou et al., "An Interleukin-4-Induced Transcription Factor: IL-4 Stat," <i>Science</i> <u>256</u> :1701-1706 (1994)
	C19	"International Human Genome Sequencing Consortium Initial Sequencing and Analysis of the Human Genome," <i>Nature</i> <u>409</u> :860-921 (2001)
	C20	Kulp et al., "A Generalized Hidden Markov Model for the recognition of Human Genes in DNA," <i>ISMB</i> <u>4</u> :134-142 (1996)
	C21	Lewis et al., "Annotating Eukaryote Genomes," <i>Curr. Opin. Struct. Biol.</i> <u>10</u> :349 (2000)
	C22	Mott, Richard, "EST_GENOME: A Program to Align Spliced DNA Sequences to Unspliced Genomic DNA," <i>Comput. Appl. Biosci.</i> <u>13</u> (4):477-478 (1997)
		Liu et al., "Design of Polydactyl Zinc-Finger Proteins for Unique Addressing Within Complex

Examiner:

Date Considered:

EXAMINER: Initial if citation considered whether or not the citation conforms with MPEP609. Draw a line through the citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

643552 v1/PA
DSKG011.DOC



Mail Stop Patent Application,
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Atty Dkt No. SABI-002/03US (S7-US4)

RECEIVED
MAY 19 2003
TECH CENTER 1600/2900

FORM PTO-1449 (Modified)
LIST OF PATENTS AND PUBLICATIONS
FOR APPLICANT'S INFORMATION DISCLOSURE STATEMENT
(Use several sheets if necessary)
Sheet 4 of 4

In the Application of CASE et al.

Serial No.: 09/942,090

Art Unit: 1631

Filed: August 28, 2001

Examiner: Unassigned

Title: GENE IDENTIFICATION

Exam. Init.	Ref. Desig.	Description
	C23	Genomes," <i>PNAS USA</i> <u>94</u> (11):5525-5530 (1997)
	C24	Neering et al., "Transduction of Primitive Human Hematopoietic Cells With Recombinant Adenovirus Vectors," <i>Blood</i> <u>88</u> (4):1147-1155 (1996)
	C25	Oligino et al., "Drug Inducible Transgene Expression in Brain Using a Herpes Simplex Virus Vector," <i>Gene Therapy</i> <u>5</u> :491-496 (1998)
	C26	Pavy et al., "Evaluation of Gene Prediction Software Using a Genomic Data Set: Application to Arabidopsis Thaliana Sequences," <i>Bioinformatics</i> <u>15</u> (11):887-899 (1999)
	C27	Reese et al., "Genie-Gene Finding in <i>Drosophila melanogaster</i> ," <i>Genome Research</i> <u>10</u> :529-538 (2000)
	C28	Rendahl et al., "Regulation of Gene Expression in vivo Following Transduction by Two Separate rAAV Vectors," <i>Nature Biotechnology</i> <u>16</u> :757-761 (1998)
	C29	Solovyev et al., "The Gene-Finder Computer Tools for Analysis of Human and Model Organisms Genome Sequences," <i>ISMB</i> <u>5</u> :294-302 (1997)
	C30	Strausberg et al., "Navigating the human transcriptome," <i>Proc. Natl. Acad. Sci. USA</i> <u>98</u> :11837-11838 (2001)
	C31	Wang et al., "Positive and Negative Regulation of Gene Expression in Eukaryotic Cells With an Inducible Transcriptional Regulator," <i>Gene Therapy</i> <u>4</u> :432-441 (1997)

Examiner:

Date Considered:

EXAMINER: Initial if citation considered whether or not the citation conforms with MPEP609. Draw a line through the citation if not in conformance and not considered. Include copy of this form with next communication to applicant.

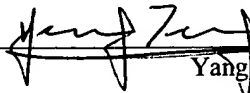
643552 v1/PA
DSKG011.DOC

Attorney Docket No. SABI-002/03US (S7-US4)

PATENT

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Mail Stop Patent Application, P.O. Box 1450, Alexandria, VA 22313-1450 on 5/13/03.

By:


Yang Tang

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of CASE et al.

Serial No.: 09/942,090

Examiner: Unassigned

Confirmation No.: 7159

Art Unit: 1631

Filed: August 28, 2001

For: GENE IDENTIFICATION

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**INFORMATION DISCLOSURE STATEMENT
UNDER 37 C.F.R. §1.97(b)**

In accordance with the duty of disclosure set forth in 37 C.F.R. §1.56,

Applicant(s) hereby submits the following information in conformance with 37 C.F.R. §§1.97 and 1.98.

- ☒ Pursuant to 37 C.F.R. §1.98, a copy of each document cited in the attached Form PTO/SB/08 is enclosed.
- ☐ No copies of the publications listed on the attached Form PTO/SB/08A are being provided pursuant to 37 C.F.R. §1.98(d) because the publications were previously cited by or submitted to the Office in prior Application Serial No. ___ to which the above-identified application claims priority under 35 U.S.C. §120.
- ☐ Publication(s) ___ listed on the attached Form PTO/SB/08A were cited in a foreign search or examination report corresponding to ___ application serial no. ___ and mailed on ___.

- ☐ Enclosed is a copy of a non-English publication(s) _____. Pursuant to §609 of the M.P.E.P., Applicant submits the attached foreign search or examination report, which cites such non-English language publication(s).
- ☐ Enclosed is a copy of a non-English publication(s) _____. English language publication ____ (copy enclosed) claims priority from this non-English publication.
- ☐ Enclosed is an explanation of non-English publication(s) ____ for which an English translation is not available.
- ☐ Enclosed is an English translation of non-English publication(s) ____ cited in the attached Form PTO/SB/08A.
- ☐ Enclosed is a copy of pending patent Application Serial No. _____.

This Information Disclosure Statement is filed within any one of the following time periods:

- ☐ within three months from the filing date of this national application other than a CPA under 37 C.F.R. § 1.53(d);
- ☐ within three months from the date of entry of the national stage as set forth in 37 C.F.R. §1.491 in this international application;
- ☒ before the mailing date of a first office action on the merits; or
- ☐ before the mailing of a first office action after the filing of a request for continued examination under 37 C.F.R. § 1.114.

It is respectfully requested that the Examiner consider the above-noted information and return an initialed copy of the attached Form PTO/SB/08A to the undersigned.

Dated: 12 May 03

Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By:

Dahna S. Pasternak
Dahna S. Pasternak
Reg. No. 41,411

1631

Attorney Docket No. SABI-002/03US (S7-US4)

PATENT

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to the Commissioner for Patents, Mail Stop Patent Application, P.O. Box 1450, Alexandria, VA 22313-1450 on 5/13/03.

By: Yang Tang
Yang Tang

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of CASE et al.

Serial No.: 09/942,090

Examiner: Unassigned

Confirmation No.: 7159

Art Unit: 1631

Filed: August 28, 2001

For: GENE IDENTIFICATION

Mail Stop Patent Application
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

INFORMATION DISCLOSURE STATEMENT TRANSMITTAL

Enclosed is an Information Disclosure Statement and accompanying Form PTO/SB/08A for the above-identified patent application.

- ☒ In accordance with 37 C.F.R. §1.97(b), no additional fee for submission of the IDS is required.
- ☐ In accordance with 37 C.F.R. §1.97(c), also enclosed is:
- ☐ the fee of \$180.00 as set forth in 37 C.F.R. §1.17(p); or
- ☐ a statement as specified in 37 C.F.R. §1.97(e).
- ☐ In accordance with 37 C.F.R. §1.97(d), a statement as specified in 37 C.F.R. §1.97(e) and the fee of \$180.00 as set forth in 37 C.F.R. §1.17(p) are also enclosed.
- ☐ Check No. ___ in the amount of \$___ for the total fee is attached.
- ☒ A return receipt postcard is also enclosed.

☐ Please charge \$__ to Deposit Account No. 03-3117 for the total fee. This paper is being submitted in duplicate.

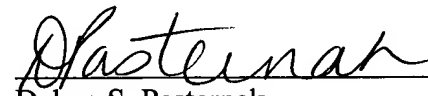
The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 03-3117.

Dated: 12 May 03

Cooley Godward LLP
ATTN: Patent Group
Five Palo Alto Square
3000 El Camino Real
Palo Alto, CA 94306-2155
Tel: (650) 843-5000
Fax: (650) 857-0663

Respectfully submitted,
COOLEY GODWARD LLP

By:


Dahna S. Pasternak
Reg. No. 41,411